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**OFFICE OF PETITIONS**

FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON DC 20007

In re Application of :  
Benneker et al. :  
Application No. 09/200,743 : ON APPLICATION FOR  
Filed: November 30, 1998 : PATENT TERM ADJUSTMENT  
Atty Docket No. 091856-0111 :  
Title: CRYSTALLINE PAROXETINE :  
METHANE SULFONATE :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed May 21, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is two thousand, seven hundred and fourteen (2714) days, not two thousand and fifty-seven (2057) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction partly on the basis that the Office will take in excess of three years to issue this patent.

In addition, applicants assert that the recalculation of the patent term adjustment as set forth in a letter regarding patent term adjustment (mailed on February 10, 2009) was made in error.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not

undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

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<sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

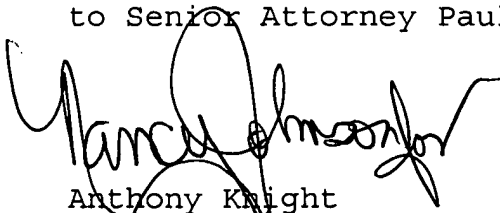
Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

To the extent that Applicants otherwise request review of the the recalculation of the patent term adjustment as set forth in the February 10, 2009 letter regarding patent term adjustment, the request is **DISMISSED**.

Applicant's assertion has been considered, but is not well taken. The reply to the restriction requirement was filed on May 31, 2001. The Letter regarding the Request for Suspension was mailed on August 2, 2001 in response to, and within four months of, the filing of the reply. Further, a review of the Letter regarding the Request for Suspension confirms that it is an Office action prepared by the Examiner as a result of the examination conducted pursuant to 35 U.S.C. 131. The Letter regarding the Request for Suspension is a notification under 35 U.S.C. 132 and properly stops the clock for determining examination delay pursuant to 37 CFR 1.703(a)(2).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.



Anthony Knight  
Supervisor  
Office of Petitions